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7-14-03
Docket No. 2598-4004US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Arthur J. BLUME et al.

Group Art Unit: 1639

Serial No.: 09/852,455

Examiner: T.D. Wessendorf

Filed: May 9, 2001

For: METHODS OF IDENTIFYING THE ACTIVITY OF GENE PRODUCTS
RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT RECEIVED

Commissioner for Patents
Washington, DC 20231

JAN 02 2003

TECH CENTER 1600/2900

Sir:

This is in response to the Office Action mailed November 26, 2002 in the above-identified application.

I. Restriction Requirement

The Examiner is requiring restriction of the claims for prosecution and has required an election of one of the following six inventions:

Group I: claims 1-16, drawn to a method of identifying a naturally occurring binding partner or its precursor for a target;

Group II: claims 17-24, drawn to a method of identifying a motif of a posttranslational gene product;

Group III: claims 25-31, drawn to a method of determining the activity of a gene product;

Group IV: claims 32-37, drawn to a method of determining the phenotypic outcome of the expression of a gene product;

Group V: claims 38-54, drawn to a method of identifying a naturally occurring binding protein;

Group VI: claim 55, drawn to a method of identifying a nucleic acid encoding a naturally occurring binding partner using a motif.

The Examiner contends that inventions I-VI are distinct from each other because inventions I-VI are unrelated. Applicant traverses the restriction required by the Examiner and respectfully requests reconsideration and removal of the restriction requirement.

The restriction requirement appears to be incomplete as there is no indication of the classification search groups defined by the Examiner. Since the Examiner has not indicated the separate classification, separate status in the art, or a different field of search, an examination of all the pending claims would not impose a serious burden on the Examiner.

See MPEP § 803 at 800-4 (emphasis added) ("If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.") Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

However, in the event the Examiner maintains the restriction requirement, Applicant elects to pursue prosecution of Group I (claims 1-16). This election is made without prejudice to Applicant's right to file and prosecute to allowance one or more continuation applications claiming priority from this application and which claims the non-elected inventions.

II. Election of Species

The Examiner contends that claims 11-14 are directed to the patentably distinct species of target moiety. The target moiety the Examiner considers distinct are:

- A.) Receptors;
- B.) Transport proteins;

- C.) Transcription regulatory sites;
- D.) Translation regulatory sites;
- E.) Protein;
- F.) Nucleic acid; and
- G.) Polysaccharide.

Applicant traverses this election requirement since all of the alternative targets may be used to practice Applicant's invention. However, in order to comply with the Examiner's requirement for election, Applicant elects species E, "Protein." At least Claims 1 – 24 and 38 – 56 are believed to read on this elected species.

CONCLUSION

In view of the above, Applicant respectfully requests reconsideration and removal of the restriction and election requirements.

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2598-4004US1.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: December 26, 2002

By:


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12-30-02

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Date of Deposit: December 26, 2002

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I hereby certify that the following attached paper(s) and/or fee

1. Response to Restriction Requirement and Election Requirement; and
2. Return Postcard.

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to Commissioner for Patents, Washington, DC 20231

Erica D. Mitchell

(Typed or printed name of person mailing paper(s) and/or fee)



(Signature of person mailing paper(s) and/or fee)

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